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Paper No. 10

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COPY MAILED

MAY 19 2004

In re Application of	:	OFFICE OF PETITIONS
Nair	:	
Application No. 09/810,957	:	ON PETITION
Filed: March 16, 2001	:	
Attorney Docket No. 032207-8000	:	

This is a decision on the petition under 37 CFR 1.137(a), and in the alternative under 37 CFR 1.137(b), filed May 13, 2004, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **dismissed**.

The petition under 37 CFR 1.137(b) is **dismissed**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time are permitted. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

The petition states that a Change of Correspondence Address is enclosed, but a copy of the form cannot be located in the file. However, the address has been changed to the address listed above. In addition, the Office has changed the attorney docket number.

A petition fee of \$110 for the petition under 37 CFR 1.137(a) and a petition fee of \$1,330 for the petition under 37 CFR 1.137(b) have been charged to deposit account no. 19-2380.

Facts:

The attorney for petitioner changed law firms. However, a Request to Change the Correspondence Address was not immediately filed.

On April 30, 2001, the Office mailed a Notice to File Corrected Application Papers (Notice) which set a period for reply of two (2) months from the mail date of the Notice.

The Notice was received by the original law firm.

A copy of the Notice was never received by the new law firm and the record fails to indicate that the original law firm attempted to forward a copy of the Notice to the new law firm.

Since no extensions of time were attained, the application became abandoned as of July 1, 2001.

A request to change the address of record was filed on October 9, 2001.

A Notice of Abandonment was mailed on February 19, 2004.

Analysis:

Petitions under 37 CFR 1.137(a) and 1.137(b) must be accompanied by the required reply. The petition and corrected drawings were submitted by facsimile transmission. Drawings may not be submitted by facsimile transmission. A request for reconsideration, along with corrected drawings, should be mailed or hand delivered to the Office.

A petition under 37 CFR 1.137(a) must be accompanied by a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”¹ The general question asked by the Office is: “Did petitioner act as a reasonable and prudent person in relation to his most important business?”² Petitioner bears the burden of proof.

The attorney for petitioner chose to rely on the original law firm rather than immediately file a request to change the correspondence address. Petitioner may choose to rely on a third party, such as the original law firm. However, such reliance will not, per se, constitute “unavoidable” delay. In order to establish unavoidable delay, petitioner would need to establish two things. First, petitioner would need to establish that reliance on the original law firm to forward all mail related to the instant application was reasonable and prudent. The petition fails to prove that the original law firm agreed to forward mail related to the instant application to the attorney for petitioner. Second, petitioner would need to prove that the original law firm acted reasonably and prudently to ensure mail would be properly forwarded. Petitioner has failed to prove that reasonable and prudent steps were taken by the original law firm to ensure all mail would be properly forwarded. If the former law firm failed to take proper precautions and made any errors, petitioner is bound by such errors.³

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
 2011 South Clark Place
 Customer Window
 Crystal Plaza Two, Lobby, Room 1B03
 Arlington, VA 22202

¹ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

² See In re Mattullath, 38 App. D.C. 497 (D.C. Cir. 1912).

³ See California Med. Products v. Technol Med. Products, 921 F. Supp. 1219, 1259 (D. Del. 1995) (citing Smith v. Diamond, 209 U.S.P.Q. 1091, 1093 (D.D.C. 1981) (citing Link v. Wabash Railroad Co., 370 U.S. 626, 8 L. Ed. 2d 734, 82 S. Ct. 1386 (1962))).

If a request for reconsideration is filed, and a decision on the new petition is not received within three months, petitioner may wish to call the number below to check on the status of the renewed petition.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

A handwritten signature in black ink, appearing to read 'C. Brantley', is positioned above the printed name.

Charles Steven Brantley
Petitions Attorney
Office of Petitions